

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF APPEALS AND INTERFERENCES**

In re Application of: Dreher, *et al.*

Serial No.:	09/482773	Group Art Unit:	1617
Filed:	January 13, 2000	Examiner:	YU, Gina
For:	Optical Makeup Composition		

**APPELLANT'S BRIEF PURSUANT TO 37 CFR 41.31**

Commissioner For Patents  
Attention: Board of Patent Appeals and Interferences  
Alexandria, Virginia 22313-1450

Sir:

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the final rejection of claims 1 to 11 and 35 in the present application in the decision of May 29, 2008.

## **REAL PARTY IN INTEREST**

The name of the real party in interest in this appeal is Color Access, Inc., the assignee of the application.

## **RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences relating to the instant application that would directly affect, be directly affected by, or have a bearing of any kind on the Board's decision in this appeal that are known to Appellants.

## **STATUS OF THE CLAIMS**

Claims 1 to 11 and 35 remain pending and finally rejected in this application. Claims 12-34 are cancelled. Claim 35 had been erroneously numbered as (new) claim 12, as submitted in the Appellant's response of December 20, 2007, in reply to the non-final office action of May 11, 2007. That numbering is corrected here. The appealed claims are those of the response mailed on December 20, 2007, which were considered and entered by the Examiner in the office action of May 29, 2008. The appealed claims are again presented herewith in the Claims Appendix. No claims were allowed, withdrawn or objected to.

## **STATUS OF AMENDMENTS**

There has been no amendment of the claims following the final rejection of May 29, 2008.

## **SUMMARY OF CLAIMED SUBJECT MATTER**

The invention of independent claim 1 is a method of reducing the appearance of lines and wrinkles associated with aging of the skin, which comprises applying to the skin exhibiting the age-associated lines and wrinkles a makeup composition comprising an interference pigment having a blue or violet reflectance, combined with at least one metal oxide pigment. (See page 2, lines 9-12 of the present specification as originally filed.)

The invention of independent claim 12 is a method of reducing the appearance of lines and wrinkles associated with aging of the skin, which comprises applying to the skin exhibiting the age-associated lines and wrinkles a makeup composition comprising an interference pigment having a blue or violet reflectance, combined with at least one metal oxide pigment and at least one inorganic, non-matte,

non-spherical powder in an amount in the range of about 2 to about 10 percent by weight based on the total weight of the composition. (See page 2, lines 9-14 and page 4, lines 28-30 of the present specification as originally filed.)

## **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

The remaining issues are: 1) whether claims 1-5, 7, 9 and 11 are anticipated by Kimura et al. (US 5,690,916; hereinafter “the ‘916 reference”) under 35 U.S.C. §102(b) as further evidenced by Wrinkles and Wrinkle Treatments ([www.skin-care-reviews.com](http://www.skin-care-reviews.com)); 2) whether claims 1-7 and 9-12 are unpatentable over Hinenno (U.S. Patent No. 6,207,174; hereinafter “the ‘174 reference”) in view of the ‘916 reference under 35 U.S.C. §103(a); and 3) whether claim 8 is unpatentable over the ‘174 reference and the ‘916 reference as applied to claims 1-7 and 9-12, and further in view of Hurst (“Face Powders”, Poucher’s Perfumes, Cosmetics and Soaps, 1993; hereinafter “Hurst”). Specifically the questions are: 1) whether anytime the composition of the ‘916 reference is applied to a blue hyperpigmented portion of the skin, the composition is inherently applied to age-associated lines and wrinkles; 2) whether the skilled artisan would have had a reasonable expectation of successfully reducing the appearance of age-associated lines and wrinkles in the skin by applying to the skin exhibiting the age-associated lines and wrinkles a composition of the ‘916 reference, comprising a blue interference pigment, in view of the teachings in the ‘174 reference; and 3) whether the skilled artisan would have modified to a cosmetic composition of the ‘916 reference, comprising a blue interference pigment, by incorporating bismuth oxychloride, as taught by Hurst, with the expectation that introducing the bismuth oxychloride would have produced a composition with luster or frosted effect to enhance the natural look of the user.

## **ARGUMENT**

For purposes of patentability, claims 1-11 and 35, drawn to the outstanding issues of the present Appeal are grouped together. Specifically, the claims are grouped together as they apply to the rejections based on 35 U.S.C. §§ 102(b) and 103(a). The outstanding issues are whether claims 1-5, 7, 9 and 11 are anticipated by the ‘916 reference as evidenced by Wrinkles and Wrinkle Treatments under 35 U.S.C. §102(b), whether claims 1-7, 9-11 and 35 are unpatentable over the combined teachings of the ‘174 and the ‘916 references, and whether claim 8 is unpatentable over the combined teachings of the ‘174 and the ‘916 references as applied to claims 1-7, 9-11 and 35, and further in view of Hurst.

The present invention is directed to a method of reducing the appearance of lines and wrinkles associated with aging of the skin, which comprises applying to the skin exhibiting the age-associated lines

and wrinkles a makeup composition comprising an interference pigment having a blue or violet reflectance, combined with at least one metal oxide pigment, and optionally, at least one inorganic, non-matte, non-spherical powder in an amount in the range of about 2 to about 10 percent by weight based on the total weight of the composition. Each of the cited references or combination of references fails to teach or suggest the invention as claimed.

#### Rejection under 35 U.S.C. §102(b)

The rejection of claims 1-5, 7, 9 and 11 has been maintained. The basis for the rejection is:

Kimura discloses a foundation comprising 9.0% by weight of blue interference pigment and iron oxides, 11.0% by weight of titanium dioxide, and sericite, other non-interference inorganic pigments. See Example 13; instant claims 1-5, 7, 9 and 11.

The claimed method of covering wrinkles of the skin as recited is inherently practiced by using the prior art composition, since wrinkles and lines are natural event and lines and wrinkles maybe visible as early as 20-25 years of age. See Wrinkles and wrinkle treatments, p.4.

The Board stated on p.6, “application of the makeup composition to the skin of a person 25 to 25 years of age and older is inherent application to skin exhibiting lines and wrinkles”. Although the new limitation now requires the method step as applying to “the skin exhibiting age-associated lines and wrinkles”, the board has clearly indicated that anytime the Kimura invention is applied to the skin of person 25 to 35 years of age and older, it is inherently applied to skin exhibiting age-associated line and wrinkles.

This rejection is again respectfully traversed.

#### The ‘916 reference

The Examiner’s anticipation rejection is based on the ‘916 reference for teaching the use of a composition containing a blue reflecting interference pigment which, when applied to skin to adjust the color of a blue hyperpigmented portion of skin, would, allegedly, inherently practice the claimed invention.

It is taught in the ‘916 reference that the compositions disclosed therein are provided for adjusting skin color so that a hyperchromic portion of the skin can become inconspicuous by virtue of an interference action by a material in the compositions. It is disclosed that the reference compositions reflect a light component which is the same color as the discolored skin and transmit only a light component to the discolored skin which is a color complementary to the discoloration (interference effect). The discolored portion of the skin then reflects the light component of complementary color thereby tricking the viewer’s eye into perceiving the discoloration as skin-colored. As disclosed in the ‘916 patent at col. 2, line 58 – col. 3, line 37, with reference to Figs. 1A, 1B and 1C, when white incident light impinges upon blue interference pigment in the reference composition applied to skin, the interference pigment reflects a blue light component of the white light and transmits only a light component which is a complementary color (e.g., red light) to the

blue hyperchromic portion of skin. The blue skin then reflects the red light and thus becomes inconspicuous or substantially indistinguishable from the surrounding normal skin. More specifically, the reference refers to adjusting a light blue hyperchromatic portion of the skin, i.e. Ota's nevus (see column 1, line 51 of the '916 reference), by application of the composition thereto. Ota's nevus occurs as a flat blue-gray pigmented lesion with an irregular border in the lateral ocular areas, and is present at birth or develops in early childhood. The manifestation is rarely described in non-Asian persons, and of those affected, 80% are female.

Claim 1 had been amended in the Appellants' response to the previous office action to make it clear that the makeup compositions comprising interference pigment having a blue or violet reflectance combined with at least one metal oxide are applied to skin exhibiting "age-associated" lines and wrinkles. Although the Examiner has considered this limitation to the claims, and has appreciated that the '916 reference does not explicitly disclose applying the compositions to lines and wrinkles of any sort, it is nevertheless the Examiner's opinion that the claimed method is inherently practiced by using the prior art compositions. The Examiner states that the Board has clearly indicated, based on the disclosure in "Wrinkles and Wrinkle Treatments" that anytime the Kimura invention is applied to the skin of person 25 to 35 years of age and older, it is inherently applied to skin exhibiting age-associated lines and wrinkles. In fact, the Board referred to skin exhibiting lines and wrinkles, not skin exhibiting "age-associated" lines and wrinkles, as the claims were amended in response to the office action of May 11, 2007, which issued after the Board decision.

Anticipation requires a showing that each limitation of a claim is found in a single reference, either expressly or inherently. However, each limitation in the present claims is not in the '916 reference, since the reference fails to explicitly or implicitly teach "applying to the skin exhibiting the age-associated lines and wrinkles a makeup composition comprising an interference pigment having a blue or violet reflectance combined with at least one metal oxide pigment". Thus, what is required by the present claims is the application of the makeup composition to skin exhibiting age-associated lines and wrinkles, not applying the makeup composition to lines and wrinkles of any noticeable level.

It also is well-settled that inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Oelrich and Divigard*, 212 USPQ 323 (CCPA 1981) (citing *In re Hansgirk v. Kemmer*, 40 USPQ 665). It must also be recognized that, in order for a reference to anticipate by inherency, the subject matter being claimed must undeniably and irrefutably follow from the prior art disclosure. *Hughes Aircraft Co. v. United States*, 8 USPQ2d 1580 (Ct. C. 1988). A person of ordinary skill in the art reading the reference and the present specification would appreciate that the method in the reference and the claimed method are not necessarily directed to the same population of people in need of such treatments on their skin. That the step of applying the '916 reference composition, comprising specifically, a blue interference pigment, to blue discolored skin in the lateral ocular area of an Asian female might possibly also involve the application of the composition to

age-wrinkled skin also is not adequate to support a rejection based on anticipation by inherency. As Ota's nevus occurs at birth or manifests itself during childhood, the reference compositions clearly may be applied to camouflage the hyperpigmented skin of a child, or a person of any age, whose skin does not yet exhibit age-associated lines and wrinkles which are conspicuous to others. Moreover, it is well known to skilled artisans in the cosmetic industry that Asian females notoriously refrain from exposing their skin to the sun, and therefore, the so-called "normal progress of wrinkles by age group" disclosed in "Wrinkles and Wrinkle Treatments" is not necessarily, and in fact, is highly unlikely to be, applicable to the skin of Asian females, or therefore to all skins. One skilled in the art simply could not have predicted that applying the '916 reference composition to the blue discolored skin of Asian children and women of any age exhibiting Ota's nevus would necessarily also practice the claimed invention. As it cannot be predicted when Asian females exhibiting Ota's nevus would also exhibit visible age-associated wrinkles, it is considered that *Perricone v. Medicis Pharmaceutical Corp.* 77 USPQ2d 1321, (Fed Cir 2005) is distinguished.

In the absence of any explicit teaching in the '916 reference that the composition also should be applied to skin exhibiting age-associated lines and wrinkles, so that the natural result of the operation disclosed in the '916 reference would always result in the claimed step of applying the composition to age-wrinkled skin, and in the absence of any showing of the Examiner by extrinsic evidence that skin of all ages and types bears age-associated wrinkles, such that practicing the prior art method would inevitably practice the claimed invention, any application of the reference composition to wrinkled skin is not inevitable, and the Examiner's reasoning is therefore inadequate to support a conclusion of anticipation.

For these reasons, claim 1 is patentable over the '916 reference. As claims 2 to 5, 7, 9 and 11 depend from and include all of the limitations of claim 1, these claims are also patentable over the cited reference.

#### Rejections under 35 U.S.C. 103(a)

##### a. Rejection of claims 1-7, 9-11 and 35

The rejection of claims 1-7, 9-11 and 35 has been maintained. The basis for the rejection is:

Hineno teaches a composite powder composition comprising interference or a reflective pigment which is effective in covering wrinkle and improving skin color. See Examples 1 and 2; Tables 2 and 3. Example 6 discloses a foundation comprising sericite, iron oxides, and 9.32% by weight of composite powder. See instant claims 1-7. Although the reference does not explicitly mention that the wrinkle is age-associated wrinkle, it would have been obvious that the prior art composition comprising interference pigments and inorganic powder would effectively camouflage the skin defect (i.e. wrinkles) regardless of the cause.

While the exemplified formulations contain 5% of red interference pigments, blue interference pigments are also taught in the specification, col. 13-14, Production Example (4), and in col. 5, Table 1. See instant claim 10.

As discussed above, Kimura teaches a foundation comprising 9% blue interference pigment and iron oxides, 11.0% by weight of titanium dioxide, and sericite, other non-interference inorganic pigments. See Example 13.

Given the teaching of Hineno that interference pigments used in cosmetics cover wrinkles on the skin, It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the exemplified cosmetic formulations of Hineno by using blue interference in a foundation as motivated by Kimura because 1) Hineno also generally teaches blue interference pigments useful for the invention; and 2) Kimura illustrates an example of a foundation comprising blue interference pigments. The skilled artisan would have had a reasonable expectation of successfully enhancing wrinkles on the skin by applying a cosmetic composition comprising blue interference pigments.

This rejection, too, is respectfully traversed.

1. the '174 reference

The Examiner's obviousness rejection is based on the '174 reference for teaching the use of compositions comprising interference pigments for covering wrinkles in the skin. The reference discloses that composite powders having a wide variety of interference colors may be produced. Compositions comprising red, blue, green and yellow interference pigments are disclosed. Makeup compositions for application to the skin and the lips employ a red reflecting interference pigment for improving skin color. It is observed in the reference that such compositions which improve skin color also camouflage the appearance of wrinkles in the skin. However, the reference fails to teach a method of reducing the appearance of lines and wrinkles associated with aging of the skin, which comprises applying to the skin exhibiting the age-associated lines and wrinkles a makeup composition comprising an interference pigment having a blue or violet reflectance, combined with at least one metal oxide pigment.

The Examiner relies on the '916 reference for teaching blue reflecting interference pigments in a makeup foundation, in an attempt to establish *prima facie* obviousness of the present invention.

2. the '916 reference

This reference is discussed above in detail in connection with the rejection under 35 U.S.C. §102(a).

3. the combined teachings of the references

The combined teachings of the references fail to render the present invention obvious because they fail to teach a method of reducing the appearance of lines and wrinkles associated with aging of the skin, which comprises applying to the skin exhibiting the age-associated lines and wrinkles a makeup composition comprising an interference pigment having a blue or violet reflectance, combined with at least one metal oxide pigment.

The Examiner contends that the '174 reference teaches, in Example 6, a foundation comprising inorganic powders and 9.32% of a red interference pigment which is effective for covering wrinkles and improving skin color. The Examiner further notes that the '916 reference teaches, in Example 13, a makeup foundation containing 9% blue interference pigment together with inorganic powders and iron oxides. The Examiner then concludes that it would have been obvious to those skilled in the art to arrive at the Appellant's invention by modifying the red interference pigment containing compositions of the '174 reference by substituting blue interference pigment for the red, because the '916 reference teaches a blue interference pigment-containing foundation and because the '174 reference teaches that blue can also be useful. The Appellants urge that this is impermissible reasoning based on the hindsight knowledge of the Appellants' invention.

The Appellants do not disagree that the '174 reference as a whole teaches that composite powders having essentially an unlimited number of interference colors may be produced for use for a variety of purposes. As stated in the reference in column 6, lines 6-12:

This interference color mainly depends on the refractive index of the core particle, the refractive index of the coating component and the film thickness of the coating component in the composite powder of the present invention as mentioned above. That is, the desired interference color can be obtained from the composite powder of the present invention by properly adjusting these factors determining the interference color.

However, the claims at issue are directed toward a specific use of a specific type of interference pigment and not to a general use of interference pigments in disguising flaws. The Examiner broadly interprets the '174 reference as teaching that any colorant may be used in the composite powder, for any purpose. However, a careful reading of the reference will show that there is nothing in the reference which would lead one skilled in the art to believe that any composition can be utilized for any purpose. One skilled in the art would appreciate that the reference as a whole more accurately teaches that, in formulating a composition, particular attention is to be paid to the type of compositions (e.g., makeup), and to the purpose for incorporating the composite powder into the makeup composition (e.g., to hide wrinkles). The reference simply does not teach expressly or implicitly that all interference pigments can be used to camouflage wrinkles. The only disclosure taught for wrinkle coverage is red interference color.

The 13 disclosed examples may be preferred embodiments of the overall invention, but from a fair reading of the entire disclosure of the '174 reference, one skilled in the art must conclude that the examples of cosmetic compositions for application to the facial skin and the lips using an interference pigment having a red reflectance are not merely preferred embodiments for the particular purpose of improving skin color and for covering wrinkles. There is explicit disclosure of a wrinkle covering capability, and that disclosure is found in the examples. Only certain compositions disclosed in the reference are indicated as useful for camouflaging



wrinkles and those are found in Examples 1 and 2, including Tables 2 and 3, in columns 14-16 of the reference. Those compositions use only composite powder (1), the particles of composite powder (1) having a light red interference color (first production example, column 13, lines 3-23 of the reference). There is absolutely nothing in the reference which would suggest that a composition comprising a composite powder having any reflectance property other than a substantially red reflectance property would demonstrate any efficacy for hiding wrinkles. Therefore, the reference fails to teach that a composition comprising a composite powder having a blue reflectance property would have any wrinkle covering effect whatsoever. The only teaching relating to wrinkles coverage which one skilled in the art could take away from this reference is that the only color that has any utility for this purpose is red.

In fact, considering the reference as a whole, it is notable that of a total of 13 examples, 7 examples are directed to cosmetic compositions. Six of the 7 examples use a pigment having a red reflectance. None of the 7 examples teaches a composition including an interference pigment having a blue reflectance. Five of the 7 examples relating to cosmetic compositions are compositions intended for application to the facial skin and the lips (facial cream, loose powder, foundations and lip cream), and all 5 of these examples employ red interference composite powder (1) for the primary purpose of improving skin color (i.e., imparting a rosy tone to the skin). In all cases, an improvement in skin color was observed after application of the red interference powder-containing compositions to the skin. In Examples 1 and 2, it is also observed, as shown in Tables 2 and 3, respectively, that the compositions which improve skin color also demonstrate a further benefit: a wrinkle covering capability. The authors of the reference provided many examples of cosmetic compositions, and had ample opportunity to provide an example of a cosmetic composition for use on the facial skin, including a composition for covering wrinkles, using an interference color other than red. Although the Examiner points out that a composition incorporating a blue interference pigment is disclosed in the reference (i.e., Example 10) that composition is not a cosmetic composition of any sort, but an adhesive. That all of the examples provided for the purpose of improving skin color and/or camouflaging wrinkles use only a pigment exhibiting a red reflectance is strong evidence that the use of only red interference color in these compositions was intended, and that these examples do not represent mere preferred embodiments, as the Examiner contends, of cosmetic compositions useful for application to the facial skin and lips for improving skin color. Although the Examiner argues that there is no evidence that it is the red tone of the color which imparts the wrinkle covering effect, Appellants urge that a careful reading of the reference would indicate otherwise, as set out in detail above.

The Examiner also states that the claimed invention is not limited to the use of interference pigments having a blue reflectance, and is open to including red pigments because violet is a mixture of blue and red. The Appellants would further urge that this interpretation of the reference is technically unsound, and that the Examiner is invited to reread the excerpt from the '174 reference set out on page 8 herein, or even better, the

entire reference, to gain a clearer understanding as to how interference pigments having a violet reflectance would be constructed.

The '174 reference teaches away from the claimed method; one skilled in the art would just not have been led to use pigments having blue (or green or yellow, etc.) reflectance colors to improve skin color, or to blur the appearance of wrinkles in the skin. The present invention is therefore both surprising and unexpected in view of the teachings in either the '916 reference, the '174 reference, or the combined teachings.

Claims 6, 7 and 12, which describe preferred embodiments of the present invention, require that the compositions employed in carrying out the claimed method comprise "at least one inorganic, non-matte, non-spherical powder in an amount in the range of from about 2 to about 10 percent by weight of the total composition". As disclosed in the present specification in the paragraph common to pages 4 and 5:

The composition also preferably contains an inorganic powder. It has been observed that, with the use of interference pigments producing only a blue or violet reflectance color in combination with metal oxides alone, these compositions do produce the desired reduction in appearance of fine lines and wrinkles, but it is an "all-or-nothing" appearance: the viewer perceives the full benefit of the reflectance from the interference pigment when looking at the skin from the specular angle, or head-on; however, when the same skin is viewed at an incident angle, the reflectance from the interference layer is not visible, and only the pigment is seen. Thus, the transition between these two views is quite sharp, and therefore somewhat less than ideal. However, it has been unexpectedly discovered that the transition between viewing at specular and incident angles can be softened by the inclusion in the formula of an inorganic powder...it is particularly preferred that the powder be a non-matte powder, in an amount of about 2 to about 10%. The most preferred powders for this purpose are plate-like, non-spherical powders that confer some luster, but not an overt shine, so that there is still some reflectance, albeit muted, even when it is not coming directly from the interference pigment.

In contrast to the compositions of claims 6, 7 and 12, employed in the claimed method, Example 13 of the '916 reference, which example is noted specifically by the Examiner, describes a composition for adjusting a light blue hyperchromatic portion of the skin which comprises inorganic, non-interference pigment powders (i.e. talc and sericite) in a total amount of 58.8% by weight of the total composition. The Appellants have discovered that limiting the compositions of the invention to no greater than 15%, and preferably, to no greater than 10%, by weight of these inorganic powders, results in a more translucent, natural appearance to the skin, created by the softening of the transition angle, as discussed above. It is urged by the Appellants that this unexpected effect would not be achieved by the composition of Example 13 of the '916 patent. There is nothing in the 916 or the '174 references which discloses or suggests limiting the inorganic powders so as to achieve the surprising effect.

The '174 reference teaches, with respect to cosmetic compositions for application to the facial skin, that improved color tone may be imparted to the skin, and that wrinkles in the skin may be covered, by applying to the skin a composition comprising a composite powder including an interference pigment having a red reflectance. The '916 reference discloses the use of red interference pigments in cosmetic compositions for adjusting the color of a red hyperpigmented portion of the skin, and the use of blue interference pigments in compositions for camouflaging a blue hyperpigmented portion of the skin. The '916 reference is completely silent about wrinkles. There is no connection of blue with wrinkles in either reference. Based on the teachings in the '174 reference, which connects red with wrinkles, one skilled in the art would simply not have been guided to substitute a blue interference pigment, as taught in the '961 reference, for the red interference pigment in the compositions of the '174 reference, for covering wrinkles.

The Examiner finds this line of reasoning unpersuasive, stating "...because the Hineno [the '174 reference] composition camouflages both hyperpigmentation and wrinkles due to the light interfering property of the pigments, which is also the active ingredient of Kimura [the '916 reference]. In view of the combined teachings of the references, examiner views that choosing the color of the interference pigments to design a cosmetic with hyperpigmented and wrinkle coverage effect is well within the skill of the art". The Appellants cannot follow the Examiner's argument. The only teaching that one skilled in the art could derive from the cited references is that a composition comprising an interference pigment having a red reflectance may camouflage wrinkles in addition to rendering a red hyperpigmented portion of the skin more natural in color so as to match the surrounding skin color. Again, there is no nexus of blue with wrinkles in the cited references. The conclusion of the Examiner is based only on hindsight knowledge of the Appellant's invention.

The combined teachings of these references therefore do not result in the claimed method. The Examiner has not therefore established a *prima facie* case of obviousness, and the invention as defined in claim 1 is patentable over the '174 and the '916 references. Claims 2 to 7, 9 to 11 and 35, which depend from and include all of the limitations of claim 1, are patentable over the cited references for the same reasons as claim 1.

**b. Rejection of claim 8**

The rejection of claim 8 has been maintained. The basis of the rejection is:

Hineno and Kimura, discussed above, fail to teach bismuth oxychloride. Hurst teaches that bismuth oxychloride is the first synthetic pearlescent pigment and now developed to provide an improved photosensitivity. See p. 117, 2<sup>nd</sup> full par. The reference further suggests that it is possible to formulate compositions using pearlescent pigments to provide "translucent luster, or frosted effect, to enhance the wearer's natural complexion". See p. 117, 5<sup>th</sup> par. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the method of the combined references by adding bismuth oxychloride to the cosmetic composition comprising blue interference pigments,

as motivated by Hurst, because of an expectation of successfully producing a composition with luster or frosted effect to enhance the natural look of the user.

This rejection, too, is respectfully traversed. The '174 and the '916 references are discussed above with respect to the earlier rejections. Hurst merely teaches the use of bismuth oxychloride in cosmetic compositions to enhance the complexion by providing luster or frost. There is no teaching in the reference related to wrinkles or to any interference pigments.

Claim 8, which is appended to claim 1, requires the presence of bismuth oxychloride in the composition used in the method recited in claim 1. The Examiner contends that it would have been obvious to have modified the combined teachings of the '174 and '916 references, by incorporating into the proposed composition, containing blue interference pigment, the bismuth oxychloride, as motivated by Hurst, and using the modified composition to reduce the appearance of wrinkles in the skin, thus arriving at the invention of claim 8. The motivation for doing so is allegedly the expectation of successfully producing a composition with luster or frosted effect to enhance the natural look of the user.

The arguments presented above, with respect to the rejection of claims 1 to 7, 9 to 11 and 35, in view of the '174 and the '916 references, are applicable here. The combination of the '174 and the '916 references is inadequate to support the rejection of claim 8, since at least one primary element of claim 1, to which claim 8 is appended, is not anticipated by or made obvious from the references. Specifically, both reference fail to teach the step of applying to the skin exhibiting age-associated lines and wrinkles a makeup composition comprising an interference pigment having a blue or violet reflectance, combined with at least one metal oxide pigment, to visibly reduce wrinkles or lines in the skin caused by aging. The '174 reference fails to teach the use of a composition comprising a blue or violet interference pigment to camouflage wrinkles or lines in the skin, and in fact, teaches only the use of a composition comprising an interference pigment exhibiting a red reflectance for wrinkle coverage. The '916 reference teaches the use of blue reflecting interference pigment to adjust the color of a blue hyperpigmented portion of the skin. Hurst merely adds the further teaching that bismuth oxychloride may be used in powders to provide luster to enhance the complexion, and fails therefore to remedy the defects of the combined teachings of the '174 and the '916 references. In none of the references is there any nexus between wrinkles and blue reflecting interference pigment. Therefore, claim 8 is patentable over the cited references.

However, claim 8 is patentable over the cited references for a further reason. One skilled in the art would not have incorporated bismuth oxychloride to add luster, as taught in Hurst, into the modified composition proposed by the Examiner, since it is disclosed in the '916 reference, at for example, column 17, lines 19-25, column 20, lines 34-39, and column 22, lines 18-23, that, after the application to skin of the composition containing the titanium dioxide coated mica (the interference pigment) a conventional foundation was applied so that the gloss of the titanium oxide coated mica was tempered or modulated to result in a

natural transparent appearance so as to yield a finish which was comparable to the normal portion of the skin. It is therefore clear from the '916 reference that the skin to which the compositions containing the interference pigment were applied appeared undesirably glossy or lustrous; that is, the hyperpigmented skin, covered using a composition containing the interference pigment, was insufficiently natural-looking without covering the compositions further with a conventional foundation. Therefore, based on the teaching in the '916 reference, one skilled in the art would not have incorporated a further luster producing component into the interference-containing compositions proposed by the Examiner.

The mere disclosure of bismuth oxychloride in the Hurst reference, when the primary elements of the claims have not been shown to be either anticipated by or obvious from the '174 and '916 references, cannot then itself render the claims obvious. Furthermore, in teaching the addition of a further lustrous component to cosmetic compositions, Hurst is contrary to the teaching in the '916 reference. Since claim 8 depends directly from claims shown above to be nonobvious in view of the cited references, dependent claim 8 must also be found to be nonobvious. See *In re Fine*, 50 USPQ 2d 1596 (Fed. Cir. 1988). As the combination of the teachings of the '174 and the '916 references with Hurst does not result in the claimed method, the Examiner has not made out a *prima facie* case of obviousness and the invention as recited in claim 8 is patentable over the references cited.

### **CONCLUSION**

In light of the arguments presented above, the anticipation rejection of claims 1 to 5, 7 and 9 to 11, based on the '916 reference, the obviousness rejection of claims 1 to 7, 9 to 11 and 35, based on the '174 reference in view of the '916 reference, and the obviousness rejection of claim 8 in view of the aforementioned references, further in combination with the Hurst reference, should be reversed as they are unfounded.

Regarding the anticipation rejection of claims 1 to 5, 7, and 9 to 11, the '916 reference is directed to adjusting the appearance of a hyperchromic portion of the skin by applying to the portion of the skin in need of color adjustment a composition containing an interference pigment having a reflected light component of complementary color to the color of the skin in need of color adjustment. The reference fails to disclose the essential step of applying the reference compositions to skin exhibiting age-associated lines and wrinkles, and therefore fails to teach each and every limitation in the present claims. Moreover, as it cannot be predicted that the application of the composition of the '916 reference to a rare and localized blue discoloration of the skin will necessarily practice the claimed invention, any application of the reference composition to wrinkled skin is not inevitable, and the Examiner's reasoning is therefore inadequate to support a conclusion of anticipation by inherency.

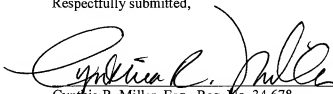
Turning to the obviousness rejection of claims 1 to 7, 9 to 11 and 35, one of ordinary skill in the art would not have looked to the '916 reference for guidance in preparing wrinkle-camouflaging compositions, since the reference is silent concerning wrinkles and is directed to adjusting the appearance of a blue or a red hyperchromic portion of the skin by applying to the portion of the skin in need of color adjustment a composition containing an interference pigment having a reflected light component of complementary color to the color of the skin in need of color adjustment. The '174 reference only teaches using a composition with an interference pigment having a red reflectance property to cover wrinkles. There is no connection of blue with wrinkles in either reference, and therefore there can be no motivation to substitute a blue reflecting interference pigment, as taught by the '916 reference for the red reflecting interference pigment in the cosmetic compositions in the '174 reference in an attempt to arrive at the Appellant's invention.

Relative to the obviousness rejection of claim 8, the Hurst reference does not provide any teaching to remedy the defects of the '174 and the '916 references, since the Hurst reference is concerned only with adding luster to cosmetic compositions and is entirely silent on reducing the appearance of age-related wrinkles in the skin, and since the mere disclosure of bismuth oxychloride, when the primary elements of the claims have not been shown to be either anticipated by or obvious from the combined teachings of the '916 and the '174 references, cannot then itself render the claims obvious. Moreover, since the '916 reference discloses that the compositions incorporating the interference pigment are already unnaturally glossy, and that tempering of the gloss by using a conventional foundation over the compositions comprising the interference pigment is needed to result in a desirable natural look of the skin, the skilled artisan would not have been led to incorporate bismuth oxychloride into cosmetic compositions containing interference pigments. Accordingly, the Appellants respectfully request that the Honorable Board reverse the decision of the Examiner finally rejecting the pending claims and declare that claims 1 to 11 and 35 in this application are allowable.

Respectfully submitted,

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## CLAIMS APPENDIX

1. A method of reducing the appearance of lines and wrinkles associated with aging of the skin, which comprises applying to the skin exhibiting the age-associated lines and wrinkles a makeup composition comprising an interference pigment having a blue or violet reflectance, combined with at least one metal oxide pigment.
2. The method of claim 1 in which the interference pigment has a blue reflectance.
3. The method of claim 1 in which the interference pigment has only a blue reflectance.
4. The method of claim 1 in which the composition comprises titanium dioxide.
5. The method of claim 1 in which the composition comprises titanium dioxide and iron oxide.
6. The method of claim 1 in which the composition further comprises at least one inorganic, non-matte, non-spherical powder in an amount in the range of from about 2 to about 10 percent by weight of the total composition.
7. The method of claim 6 in which the powder is selected from the group consisting of bismuth oxychloride, boron nitride, barium sulfate, mica, sericite, muscovite, synthetic mica, titanium oxide coated mica, titanium oxide coated bismuth oxychloride, titanium oxide coated talc, platelet iron oxides, aluminum powder, lauroyl lysine and platelet talc.
8. The method of claim 1 in which the composition further comprises bismuth oxychloride.
9. The method of claim 1 in which the composition comprises from about 1 to about 9% by weight of interference pigment.
10. The method of claim 8 in which the composition comprises from about 2 to about 8% by weight of the interference pigment.
11. The method of claim 10 in which the interference pigment has only a blue reflectance.

35. A method of reducing the appearance of lines and wrinkles associated with aging of the skin, which comprises applying to the skin exhibiting the age-associated lines and wrinkles a makeup composition comprising an interference pigment having a blue or violet reflectance, combined with at least one metal oxide pigment and at least one inorganic, non-matte, non-spherical powder in an amount in the range of about 2 to about 10 percent by weight based on the total weight of the composition.



## **EVIDENCE APPENDIX**

No evidence is presented.

## **RELATED PROCEEDINGS APPENDIX**

There are no related proceedings or decisions.